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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,259	08/18/2006	Yoshihito Kanasashi	115942-012	6094
43793 7590 03/17/2009 EVEREST INTELLECTUAL PROPERTY LAW GROUP P. O. BOX 708 NORTHBROOK, IL 60065				
EXAMINER				
DENTER, CLARK F				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
03/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,259

Applicant(s)

KANASASHI ET AL.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2 and 5-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 18 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed on December 2, 2008 has been entered.

Claim Objections

2. Claims 1, 2 and 5-8 are objected to because of the following informalities:
In claim 1, line 12, it seems that a word such as --an-- is missing before "outside".
In claim 5, line 3, it seems that --is-- should be inserted after "punched" for clarity.
Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee, pn 6,089,137.

Lee discloses a device with every structural limitation of the claimed invention including:

a punch (e.g., shown in a detached, raised position in Fig. 8) including a punch station (e.g., 40) formed with a slit into which a sheet to be punched is to be inserted and a guide hole (e.g., through the lower portion of 50 and through 70) for guiding a

punching blade in a direction intersecting with the slit, the punching blade to be guided by the guide hole, an operating section (e.g., an upper portion of 56) for operating the punching blade, and a housing (e.g., 60) which accommodates the punch station and the punching blade and which is formed with an opening (e.g., 62) in which the operating section is disposed; and

a punch auxiliary tool (e.g., shown in Fig. 8) having an auxiliary tool station (e.g., the portion contacted by the lead line for numeral 30 in Fig. 2) and a pair of arms (e.g., the two opposing longitudinally-extending portions of 32) rising from both sides of the auxiliary tool station and a pressing operating member (e.g., 10) which is pivotally supported by the arms,

wherein an inserting/detaching opening (e.g., shown with arrows in Fig. 8) is formed on a side of the punch auxiliary tool where the pressing operating member is pivotally supported such that the inserting/detaching opening is open and accessible to outside of the punch auxiliary tool when the pressing operating member is pivoted toward the auxiliary tool station (e.g., as viewed in Fig. 8, when pivoting the pressing member 10 a small amount toward the auxiliary tool station, the inserting/detaching opening is accessible to an outside of the punch auxiliary tool), the inserting/detaching opening capable of inserting and detaching the punch in such a state that a side of the punch where the slit is formed is directed to the side of the punch auxiliary tool where the pressing operating member is pivotally supported, and a lower surface of the pressing operating member of the punch auxiliary tool is provided with a pressing

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section (e.g., 14) which presses the operating section inserted from the inserting/detaching opening;

[claim 2] wherein in a state where the operating section of the punching blade is disposed in the opening of the housing, the punch station and the punching blade are accommodated in the housing such that the operating section is substantially flush with an upper surface of the housing (e.g., as shown in Figs. 7 and 8).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee, pn 6,089,137 in view of Mori et al., pn 4,509,397 (hereafter Mori '397).

Lee discloses a device with almost every structural limitation of the claimed invention but lacks the device having a positioning tool and the details thereof. However, such positioning tools are old and well known in the art and provide various well known benefits including holding a workpiece in position relative to a punch tool to prevent or reduce the likelihood of inaccurate punching operations. Mori '397 discloses one example of such a positioning tool as follows:

[claim 5] further comprising a positioning tool (e.g., 2) including a mounting stage (e.g., 27) on which the sheet to be punched is placed, and sheet holding means (e.g., 20) for holding the sheet to be punched placed on the mounting stage, wherein a to-be-retained portion (e.g., including 7) provided on the punch or punch auxiliary tool is engaged with a retaining portion (e.g., 25) provided on the positioning tool, and a punching position in the sheet to be punched is set;

[claim 7 (from 5)] wherein the retaining portion comprises a plurality of the retaining portions (e.g., 25) arranged along the end edge of the mounting stage at equal distances from one another;

[claim 8 (from 7)] wherein a retaining position of the to-be-retained portion which is engaged with the retaining portion can be changed selectively.

Therefore, it would have been obvious to one having ordinary skill in the art to provide such a positioning tool for use with the punching device of Lee, and/or to adapt

Lee for use with such a positioning device, to gain the well known benefits including those described above.

Regarding claim 6, the combination of Lee and Mori '397 lacks:

[claim 6 (from 5)] wherein a ruler is mounted on a mounting stage of the positioning tool, the ruler member includes a ruler portion against which an end edge of the sheet to be punched can abut, the ruler member can turn toward its back surface from a position where a surface of the mounting stage is substantially flush, the end edge of the mounting stage which is exposed when the ruler member is turned toward the back surface of the mounting stage is provided with the retaining portion.

However, the Examiner takes Official notice that such ruler devices are old and well known in the art in various forms and provide various well known benefits including providing a workpiece alignment mechanism that provides a visual measure of the workpiece and the portion(s) thereof to be cut. Therefore, it would have been obvious to one having ordinary skill in the art to provide such a ruler device on the device of Lee and Mori '397 to gain the well known benefits including that described above.

Response to Arguments

7. Applicant's arguments filed December 2, 2008 have been fully considered but they are not persuasive. It is respectfully submitted that the prior art teaches and/or fairly suggests the claimed invention as described in further detail in the prior art rejections above, and thus the prior art rejections must be maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cf
March 14, 2009